



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,274	12/12/2000	L. Michael Maritzen	SON5180.02A	7901

36813 7590 11/23/2004

O'BANION & RITCHEY LLP/ SONY ELECTRONICS, INC.
400 CAPITOL MALL
SUITE 1550
SACRAMENTO, CA 95814

EXAMINER

ELISCA, PIERRE E

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,274

Applicant(s)

MARITZEN ET AL.

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action is in response to Applicant's RCE filed on 11/01/2004.
2. Claims 1-23 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-8, 11-20, and 23 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Johnson (U.S. Pat. No. 6,529,885) and Porterfield et al. (U.S. Pat. No. 5,878,235) in view of Kanter (U.S. Pat. No. 5,537,314).**

As per claims 1, 5-8, 11-20 and 23 Johnson substantially discloses an inventive concept of carrying out electronic transactions including electronic drafts, wherein payment on at least one of the drafts is contingent upon the removal of an associated contingency (which is equivalent to Applicant's claimed invention wherein it is stated that a system for performing electronic commerce transactions), comprising: a transaction terminal configured to receive a user transaction device that coupled to the transaction terminal, said transaction terminal further configured to indicate that a

Art Unit: 3621

transaction is to be performed (see., figs 1A and 1B, col 9, lines 5-67, col 10, lines 1-60);

a transaction privacy clearinghouse configured to communicate with the transaction device when a transaction is to be performed, said transaction privacy clearinghouse further configured for receipt of said device identifier and capable thereupon of authorizing a transaction on behalf of a user associated with said device identifier after the identity of said user has been verified (see., abstract, specifically wherein it is stated that parties and contingency approvers requesting access to the computer site are authenticated by encrypting identification information, and also Johnson does teach clearinghouses that form an integral part of negotiating a conventional paper check see., col 7, lines 26-64); and

an escrow account associated with the transaction privacy clearinghouse which is configured for receiving and dispersing forms of remuneration associated with authorized transactions (see., col 24, lines 43-67, col 25, lines 1-28). It is to be noted that Johnson fails to explicitly disclose a device identifier. However, Porterfield discloses a device identifier field 102 that identifies the status of each transaction (see., col 6, lines 14-29, lines 37-530. accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic transactions of Johnson by including the limitation detailed above as taught by Porterfield because this would ensure that electronic transaction is properly secured.

Johnson and Porterfield fail to disclose Applicant's newly added limitation wherein said accumulating incentive-based remuneration in the form of cas or non-cash value-

Art Unit: 3621

units as received from vendors. Kanter discloses a referral recognition system for an incentive award program. A item of merchandise that could be ordered through a catalog depended on the amount of points achieved by the participant. Hence, a participant who earned more points under the incentive program could order more expensive merchandise (or cash), or more items of merchandise, than one who had a lesser accumulation of incentive points (see., abstract, col 5, lines 10-50). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Johnson and Porterfield by including the limitation detailed above as taught by Kanter because this would increase the market value of the company sponsoring the incentive program.

As per claims 2, 3, 4, and 22 Johnson discloses the claimed limitations of executing unit configured to automatically perform a transaction upon receiving a selected invoice or bill from a vendor that meets certain predetermined verification criterion (see., col 3, lines 9-29, specifically wherein it is stated that make payment or bill as the contingencies are met).

5. Claims 9, 10, and 21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Johnson, Porterfield, and Kanter in view of Biffar (U.S.Pat. No. 6,047,269).

As per claims 9, 10, and 21 Johnson, Porterfield, and Kanter disclose the claimed limitations as stated in claims 8, 6 and 1 above. It is to be noted that Johnson,

Art Unit: 3621

Porterfield, and Kanter fail to explicitly disclose an incentive unit or coupon, digital currency. However Biffar discloses a self-contained payment which includes a voucher at a time of transaction such as coupons (see., col 5, lines 23-27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Johnson and Porterfield by including the incentive process taught by Biffar because such modification would provide the electronic transactions of Johnson with the enhanced capability of creating digital coupons or voucher or incentive which will facilitate a fast electronic transaction.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

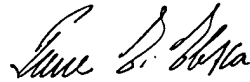
Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

November 18, 2004